



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,414	02/01/2002	Noriyoshi Hiraoka	FS.F4138US2RAC	4645

20995 7590 05/12/2004

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

EXAMINER

BASINGER, SHERMAN D

ART UNIT PAPER NUMBER

3617

DATE MAILED: 05/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/066,414

Applicant(s)

HIRAOKA ET AL.

Examiner

Sherman D. Basinger

Art Unit

3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 16-18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-12 is/are allowed.
- 6) ☒ Claim(s) 16-18 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/1/02 & 1/26/04 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/857016.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The finality of the office action mailed October 14, 2003 has been withdrawn in order to make a new grounds of rejection with regard to claims 16, 17, 18 and 20.

2. In order for the response filed March 18, 2003 and the declaration filed March 23, to be timely, a three month extension of time under 37 CFR 1.136(a) was required. The fee for a three month extension of time is \$950.00. Applicant paid \$110.00 for a one month extension of time on January 26, 2004 and paid \$110.00 for a second one month extension of time on March 18, 2004. As such, a fee of \$730.00 was required.

With the declaration filed March 23, 2004 applicant included a TRANSMITTAL in which applicant stated: Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

As such, a fee of \$730.00 was charged on April 9, 2003 to Deposit Account No. 11-1410.

Mr. Guiliana, applicant's representative, was informed of the above charge by telephone on April 9, 2004.

3. The amendment after final filed March 18, 2004 and the oath or declaration filed March 23, 2004 have been entered. *It is noted that in the response filed March 18, 2003, the status of all patent claims set forth in the amendment filed March 18, 2003 was incomplete as applicant failed to mention that claim 19 was canceled.*

4. The amended sheets of drawings filed January 26, 2004 have been approved.

5. Claims 1-12, 16, 17, 18 and 20 are pending. The pending claims were entered on the following dates: claims 1, 3-10 and 12 were originally filed February 1, 2002; claims 16, 17, 18 and 20 were entered on September 22, 2003; and claims 2 and 11 were entered on March 18, 2004.

Reissue Applications

6. Claims 16-18 and 20 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001); *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Applicant surrendered the following subject matter in the application for patent 5,893,783.

For claim 1 the surrendered subject matter is "and a vertically extending exhaust manifold in said valley for collecting exhaust gasses from said exhaust passages, said

exhaust manifold terminating in a single downwardly extending discharge passage extending into said driveshaft housing and lower unit, an exhaust cooling jacket surrounding said single discharge passage and said exhaust manifold" and "means for delivering cooling water from the body of water in which the associated watercraft is operating first to said exhaust cooling jacket and from said exhaust cooling jacket to said engine body cooling jacket".

In the response filed August 17, 1998, applicant argued:

The art which the Examiner has cited is admittedly relevant to the broader claims originally submitted. However, there is an important feature that is believed to distinguish applicant's invention over all of the cited art, and this feature has been stressed in amended claim 1.

The feature is the provision of a separate cooling jacketed exhaust manifold in the valley between the banks of the V-type outboard motor. In connection with this, the prior art teaches the idea of combining a water jacket for the exhaust manifold with the water jackets for the engine. As a result, the engine temperature can run higher than desired because of a significant heat exchange between the exhaust system and the engine. Also, the amount of cooling for the exhaust gases is substantially minimized.

With applicant's invention, the exhaust manifold positioned in the valley between the cylinder banks is provided with a separate cooling jacket, and this cooling jacket receives water first. Then, from the exhaust manifold cooling jacket, the coolant is delivered to the cooling jackets to the engine body. This

feature is not taught or suggested in the art of V-type outboard motor engine arrangements.

None of the references of record that have been applied suggest this feature, and, therefore, it is submitted that the foregoing amendment places this case in condition for favorable action.

The above limitations were presented and argued in the response filed August 17, 1998 in the original application to make claim allowable over the art rejection set forth in the office action mailed April 23, 1998 in the original application (that for patent 5,893,783).

For claim 8, the surrendered subject matter is "a starter motor is positioned in a space between said exhaust manifold and said engine". Applicant stated in the response filed August 17, 1998 in the original application:

Turning now to the art rejection and the action on the claims on their merits, the indicated allowability of Claims 14, 16 and 17, subject to their being rewritten in independent form, is noted with appreciation. By virtue of the foregoing amendment, Claim 9 is being amended so as to constitute Claim 14 in independent form.

Claim 9 upon allowance was renumbered as claim 8 referenced above. Claim 14, indicated as containing allowable subject matter in the office action mailed April 23, 1998 in the original application, read as follows: The exhaust system in accordance with claim 10, wherein a starter motor is positioned in a space between said manifold and said engine.

This limitation was stated by applicant in the original application to make claim 8 allowable over any art rejection set forth in the office action mailed April 23, 1998.

For claim 11, the surrendered subject matter is "a lubricant passage and a coolant passage extending through said valley, said coolant passage being positioned between said lubricant passage and said main exhaust passage". Applicant stated in the response filed August 17, 1998 in the original application:

Turning now to the art rejection and the action on the claims on their merits, the indicated allowability of Claims 14, 16 and 17, subject to their being rewritten in independent form, is noted with appreciation.

Claim 15 has been canceled and Claims 16 and 17 have been rewritten in independent form so as to include all of the limitations of the claims upon which they depend.

Claim 16 upon allowance was renumbered as claim 11 referenced above. Claim 16, indicated as containing allowable subject matter in the office action mailed April 23, 1998 in the original application, read as follows: The exhaust system in accordance with Claim 15, wherein said engine includes a lubricant passage and a coolant passage extending through said valley, said coolant passage positioned between said lubricant passage and said main exhaust passage.

This limitation was stated by applicant in the original application to make claim 11 allowable over any art rejection set forth in the office action mailed April 23, 1998.

For claim 12, the surrendered subject matter is "a coolant jacket extending about said exhaust passage, a coolant passage positioned within said cylinder block adjacent each combustion chamber, and at least one oil passage extending through said valley generally parallel to said main exhaust passage, said coolant jacket and coolant passage extending between said at least one oil passage and said exhaust passage".

Applicant stated in the response filed August 17, 1998 in the original application:

Turning now to the art rejection and the action on the claims on their merits, the indicated allowability of Claims 14, 16 and 17, subject to their being rewritten in independent form, is noted with appreciation.

Claim 15 has been canceled and Claims 16 and 17 have been rewritten in independent form so as to include all of the limitations of the claims upon which they depend.

Claim 17 upon allowance was renumbered as claim 12 referenced above. Claim 17, indicated as containing allowable subject matter in the office action mailed April 23, 1998 in the original application, read as follows: The exhaust system in accordance with Claim 15, including a coolant jacket extending about said exhaust passage, a coolant passage positioned within said cylinder block adjacent each combustion chamber, and at least one oil passage extending through said valley generally parallel to said main exhaust passage, said coolant jacket and coolant passage extending between said at least one oil passage and said exhaust passage.

This limitation was stated by applicant in the original application to make claim 12 allowable over any art rejection set forth in the office action mailed April 23, 1998.

As a result of *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366, 59 USPQ2d, 1597 (Fed. Cir. 2001), the following can be stated.

If a claim limitation is presented/argued/stated in an original application to make the claims allowable over an art rejection made in the original application, and the claim limitation is then omitted, in its entirety, in the reissue application claims, then the omitted limitation relates to subject matter previously surrendered by applicant and impermissible recapture of the surrendered subject matter exists. Claims 16 and 17 omitted a claim limitation (any one of the limitations of claims 1, 8, 11 and 12 discussed above as surrendered subject matter) presented/argued/stated in an original application to make the claims allowable over any art rejection made in the original application.

Allowable Subject Matter

7. Claims 1-12 are allowed.

Conclusion

8. It is courteously requested that applicant refile a copy of the Certificate of Corrections dated twenty-first day of August, 2001. That previously filed has been misplaced and is no longer in the file of the instant application.

9. It is pointed out that in accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sherman D. Basinger whose telephone number is 703-308-1139. The examiner can normally be reached on M-F (6:00-2:30 ET).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel J. Morano can be reached on 703-308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/066,414

Page 10

Art Unit: 3617


Sherman D. Basinger
Primary Examiner
Art Unit 3617

5/4/04

Sdb
5/4/04